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| 10/758,220 | 01/16/2004 | Tatsuya Mitsugi | Q79265 | 5741 |
| 23373 7590 05/28/2008 | | | | |
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| EXAMINER | | | | |
| WHIPPLE, BRIAN P | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/758,220

Applicant(s)

MITSUGI ET AL.

Examiner

Brian P. Whipple

Art Unit

2152

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 May 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

/Jeffrey Pwu/
Supervisory Patent Examiner, Art Unit 2146

Continuation of 13. Other:

Examiner has read and strongly considered Applicant's remarks and arguments filed on 5/22/08, but in light of a review of the prior art relied upon, Examiner believes the original rejections may be maintained.

Examiner and Applicant have previously discussed whether or not an identifier must be present for each TV related to the count of TVs tuned to a selected channel. Examiner has further reviewed the prior art and still believes Blahut may be interpreted as disclosing the relevant limitation. Applicant is arguing that Blahut need not track an identifier, as it may merely detect a TV switching to another channel, decrement the count for that channel, and if the TV switches back, increment the count. However, Examiner feels that in order to know if the RF transmission tuning to a selected channel is from a remote control indicates the remote was previously inactive ([0026], lines 1-3) an identifier must be stored in order to track if such a remote control was inactive, each remote being linked to a TV. Additionally, Examiner feels an identifier for each TV must be stored related to its selected channel for the following reason. A transmission signal to change channels does not possess two separate instructions (i.e. when a person sends a channel up signal to the TV from a remote, it does not first instruct the TV to stop processing of the current channel and then send a second signal to move up in the channels), rather a signal is simply sent to change to the new channel. Therefore, in order to properly decrement the count for the channel from which the TV is moving, it must be known what channels each TV is tuned to, and therefore, when the channel change instruction is received from the TV, the system may track the previous channel and decrement its count. Without the storage of identifiers, it would not be possible to track how many TVs are tuned to a selected channel, because the system would only know that a TV is changing to a new channel (based on the change channel instruction) and would not know if the TV was tuning from channel 1, 2, 3, etc. In other words, without identifiers, the system could only increment counts when channel change requests were received, but would have no way to decrementing counts, as no identifiers were stored to indicate previous channel assignment.

The following is an excerpt from the previous Office action mailed 2/25/08: "As to claim 1, Applicant argues Blahut does not disclose transmitting specific information to which the identifier is added as the selected video channel does not have any identifier added onto it. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Specifically, claim 1 merely claims "adding the identifier associated with said instruction to the specific information associated with said instruction" and "transmitting the specific information to which the identifier is added." Giving the broadest reasonable interpretation, this may be interpreted as tracking a corresponding identifier for an entity requesting a program, and then providing the program to the identified entity. The claim is not specific enough to require that the identifier be embedded in the program as argued by Applicant. Blahut discloses adding identifiers of televisions viewing a selected program and providing the program to the identified televisions in response. Clearly the identifier must be present in order to properly feed the programs to the units."

Examiner feels the reasoning of the previous paragraph may be maintained. Examiner has further reviewed his reasoning and the language of the claim, and still feels the broadest reasonable definition of "adding" and "transmitting" corresponds to the reasoning and rejection given. Namely, maintaining a look-up table that links a selected channel number and the identifiers of televisions/remotes tuned to said channel, and transmitting the selected programs to the corresponding televisions. There is a difference between adding information to other information and inserting information directly into or onto other information. A table with two columns, wherein first a selected channel number is inserted to the first column, and then a specific identifier to receive the channel number is added to the second column, would be one example of addition as opposed to integration in a fundamental way.

Applicant's arguments regarding Blahut not disclosing a common connection line, as wireless and coaxial are used, and not wireless alone, may be persuasive. However, even if this reasoning of Blahut alone fails, Examiner still is able to rely upon the combination of Blahut and Magendanz. Applicant's arguments that Magendanz may not be incorporated into Blahut because Blahut transmits programs via coaxial and a common connection line would render it impossible to transmit different channels is not a convincing argument for patentability. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). A plurality of monitors displaying a plurality of images/programs such as in Magendanz have been known in the art, and it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Blahut and Magendanz in a way that renders Applicant's invention obvious.

Applicant's arguments that Examiner has not properly responded to the arguments regarding claim 3 is not convincing. Examiner believes the arguments related to claim 1 are still applicable. Namely, [0026], the fifth bullet, of Blahut show the limitations of claim 3 in that if other TVs are viewing a selected channel, only an ID is added, otherwise, both the channel transmission and the ID would be added (see [0026], first bullet as well).

Applicant's arguments regarding claims 15 and 17 are not convincing for the reasons given above in relation to a common connection line.